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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,839	12/16/2003	Satoshi Nishikawa	00862.023373.	5424

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
EBRAHIMI DEHKORDY, SAEID	
ART UNIT	PAPER NUMBER
2625	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/735,839	NISHIKAWA ET AL.	
	Examiner	Art Unit	
	Saeid Ebrahimi-dehKordy	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 16 December 2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 4/6/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11 rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al (Pub. No.: US 20050060650)

Regarding claim 1 Ryan et al disclose: A method of controlling an information processing apparatus which supplies print data to a printer, comprising: a determination step of determining whether or not a document includes a page which is not printed by the printer (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) a print setting structure output step of outputting (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) when it is determined in the determination step that the document includes a page which is not printed by the printer (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing form the print job) a print setting structure that instructs to set a non-billing page to rendering means of an OS (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) and a print data generation step of generating, when the print setting structure that instructs to set a non-billing page is received via the rendering means of the OS, a non-billing command (note Fig.11,

steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078, where the command is given to fetch the missing sheet and sent to the printer).

Regarding claim 2 Ryan et al disclose: A method of controlling an information processing apparatus that supplies print data to a printer which comprises middle insert means for inserting an independently fed index sheet between printed print sheets upon printing and exhausting print sheets, comprising: a setting step of setting whether or not an index sheet is to be inserted; and an instruction step of instructing, when it is set in the setting step that the index sheet is to be inserted, the printer to exclude the index sheet to be inserted from sheets to be billed.

Regarding claim 3 Ryan et al disclose: The method according to claim 2, further comprising a determination step of determining whether or not the printer is compatible to an instruction issued in the instruction step (note Fig.6, paragraph 0052, where the capabilities of the targeted printers are determined).

Regarding claim 4 Ryan et al disclose: A program for making a computer connected to a printer, which comprises middle insert means for inserting an independently fed index sheet between printed print sheets upon printing and exhausting print sheets, execute: a setting step of setting whether or not an index sheet is to be inserted; and an instruction step of instructing, when it is set in the setting step that the index sheet is to be inserted, the printer to exclude the index sheet to be inserted from sheets to be billed.

Regarding claim 5 Ryan et al disclose: An information processing apparatus that supplies print data to a printer which comprises middle insert means for inserting an independently fed index sheet between printed print sheets upon printing and exhausting print sheets comprising: setting

means for setting whether or not an index sheet is to be inserted (note page 6 paragraph 0046, and specifically lines 26 through 31) and instruction means for, when said setting means sets that the index sheet is to be inserted (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) instructing the printer to exclude the index sheet to be inserted from sheets to be billed (note page 6 paragraph 0046, and specifically lines 26 through 31).

Regarding claim 6 Ryan et al disclose: A print system having a printer which comprises middle insert means for inserting an independently fed index sheet between printed print sheets upon printing and exhausting print sheets (note page 6 paragraph 0046, and specifically lines 26 through 31) and a host computer connected to said printer, said host computer comprising: setting means for setting whether or not an index sheet is to be inserted (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) and instruction means for when said setting means sets that the index sheet is to be inserted (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) instructing said printer to exclude the index sheet to be inserted from sheets to be billed and said printer comprising: count means for counting the number of printed sheets for the purpose of billing (note page 6 paragraph 0046, and specifically lines 26 through 31) and control means for controlling a count operation of said count means on the basis of an instruction from said instruction means (note page 14, paragraphs 0092 and 0094).

Regarding claim 7 Ryan et al disclose: A method of controlling an information processing apparatus that supplies print data to a printer which comprises 2-sided print means for forming

images on two faces of a print sheet and exhausting the printed print sheet, comprising: a setting step of setting whether or not a blank sheet is to be inserted at a predetermined division position (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) and an instruction step of instructing, when it is set in the setting step that the blank sheet is to be inserted (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) the printer to exclude the blank sheet to be inserted from sheets to be billed (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078).

Regarding claim 8 Ryan et al disclose: The method according to claim 7, further comprising a determination step of determining whether or not the printer is compatible to an instruction issued in the instruction step (note Fig.6, paragraph 0052, where the capabilities of the targeted printers are determined).

Regarding claim 9 Ryan et al disclose: A program for making a computer that supplies print data to a printer which comprises 2-sided print means for forming images on two faces of a print sheet and exhausting the printed print sheet, execute: a setting step of setting whether or not a blank sheet is to be inserted at a predetermined division position (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) and an instruction step of instructing, when it is set in the setting step that the blank sheet is to be inserted (note Fig.11, steps 201 through 206, where the steps for structuring the process of the outputting is set, page 11, paragraph 0076-0078) the printer to exclude the blank sheet to be inserted from sheets to be billed (note page 6 paragraph 0046, and specifically lines 26 through

31).

Regarding claim 10 Ryan et al disclose: An information processing apparatus that supplies print data to a printer which comprises 2-sided print means for forming images on two faces of a print sheet and exhausting the printed print sheet, comprising: setting means for setting whether or not a blank sheet is to be inserted at a predetermined division position (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) and instruction means for, when said setting means sets that the blank sheet is to be inserted, instructing the printer to exclude the blank sheet to be inserted from sheets to be billed (note page 6 paragraph 0046, and specifically lines 26 through 31).

Regarding claim 11 Ryan et al disclose: A print system which has a printer which comprises 2-sided print means for forming images on two faces of a print sheet and exhausting the printed print sheet, and a host computer connected to said printer, said host computer comprising: setting means for setting whether or not a blank sheet is to be inserted at a predetermined division position (note Fig.16, page 14, paragraph 0094, lines 6-8, where it is determined whether the sheet is missing from the print job) and instruction means for, when said setting means sets that the blank sheet is to be inserted, instructing the printer to exclude the blank sheet to be inserted from sheets to be billed (note page 6 paragraph 0046, and specifically lines 26 through 31) and said printer comprising: count means for counting the number of printed sheets for the purpose of billing (note page 14, paragraph 0094) and control means for controlling a count operation of said count means on the basis of an instruction from said instruction means (note page 14, paragraphs 0092 and 0094).

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 703-306-3487. The examiner can normally be reached on Mon-Fri,8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Saeid Ebrahimi
Patent Examiner
Group Art Unit 2625
September 1, 2007